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MURDOUGH, JOSHUA A

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,868

**Applicant(s)**

GUNYAKTI ET AL.

**Examiner**

JOSHUA MURDOUGH

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 C.F.R. §1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 16 January 2008 has been entered.

### ***Acknowledgements***

2. In accordance with the RCE noted above, claims 1-25 are pending and have been examined.

### ***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-7 claim a system and a method, which renders the claim ambiguous. For examination purposes, the examiner will interpret these claims as being directed to a method only. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-7 are rejected under 35 U.S.C. §101 because the claims are directed to neither a “process” nor a “machine” but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C 101 which is drafted so as to set the statutory classes of invention in the alternative only. For examination purposes, the examiner will interpret these claims as directed to a method only.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 4, 5, 8-18, 21, 24, & 25 are rejected under 35 U.S.C. §102(e) as being anticipated by Coley (20020161718).
10. As to claim 1, Coley shows:
- a. A system for supporting the enforcement of a license for a computer program,  
(Abstract) the system comprising:

- b. a licensing component (Figure 1, #110) that maintains a license store in which the license is stored (Figure 1, #112), the licensing component further maintains a trust store (Paragraph [0018]) in which dynamic data is stored in a tamper-resistant manner (Paragraph [0093]), wherein the dynamic data is utilizable to validate the license (Paragraph [0050]), the license comprising a right (execution) in the software and a set of data associated with said right (Paragraph [0050]), the licensing component exposing a callable interface to the computer program, said callable interface comprising:
  - c. a right-consumption method which receives an identifier of said right from the computer program and determines whether the right can be exercised; (Figure 2, A-B) and
  - d. an information-retrieval method which receives an identifier of said right from the computer program and provides said set of data, or information based on said set of data, to the computer program. (Figure 2(cont.), B-A)
- 11. As to claim 4, Coley further shows:
  - e. the licensing component does not enforce licensing constraints on the computer program (the responses to the license being invalid are shown in paragraphs [0052+], however, the Examiner finds no reference to the license component **110** performing any of them.) , and
  - f. said callable interface further comprises: an asynchronous-context-initiator method that establishes a context for asynchronous processing and provides an identifier of said context to the computer program; wherein said rights-consumption method receives the identifier of said context from said computer program and processes a right-

consumption request asynchronously in response to receipt of the identifier of said context. (Paragraph 0049 & Figure 2 (cont.), #236)

12. As to claim 5, Coley further shows:

the rights-consumption method determines whether the right can be exercised based on whether the right is identified in the license. (Paragraph 0047)

13. As to claim 8, Coley shows:

g. A method of restricting the use of a computer program (Figure 2 (cont.), #226) associated with a license (Figure 2, #202), the license specifying a right in the computer program, the method comprising:

h. invoking a licensing service by making a first call to a first method of an interface of said licensing service, the licensing service in communication with a trust store (Paragraph [0018]) in which dynamic data is stored in a tamper resistant manner (Paragraph [0093]), wherein the dynamic data is utilizable to validate the license (Paragraph [0050]), said first call being parameterized by an identifier associated with said right (execution); (Figure 2, #210)

i. in response to said first call receiving an indication as to whether the right is exercisable; (Figure 2, #214) and engaging in either a first behavior (Figure 2, #218) or a second behavior according to the indication. (Figure 2, #216)

14. As to claim 9, Coley further shows:

j. said first behavior comprises allowing the computer program to execute (Figure 2 (cont.), #230), and

- k. wherein said second behavior comprises discontinuing execution of the computer program. (Figure 2 (cont.), #226).
15. As to claim 10, Coley further shows:
- said first behavior comprises allowing the computer program to perform a first set of functions, and wherein said second behavior comprises allowing the computer program to perform a second set of functions that is non-identical to said first set of functions. (Paragraph 0023)
16. As to claim 11, Coley further shows:
- l. the right is associated with a set of data, (Paragraph 0071)
  - m. wherein the method further comprises: making a second call to a second method of said interface, said second method being parameterized by an indication of the right; (Figure 2 (cont.), #224) and in response to said second call, receiving said set of data. (Figure 2 (cont.), #228)
  - n. As to claim 12, Coley further shows:
  - o. directing the operation of the computer program based on said set of data. (Paragraph 0048)
17. As to claim 13, Coley further shows:
- p. making a second call to a second method of said interface; and in response to said second call, receiving a handle; (Paragraph 0088)
  - q. wherein said second call is made prior to said first call, (Paragraph 0046) and
  - r. wherein said first call is further parameterized by said handle. (Paragraph 0088)
18. As to claim 14: Coley further shows:

making a second call to a second method of said interface; and in response to said second call, receiving an asynchronous context; wherein said second call is made prior to said first call, wherein said first call is further parameterized by said asynchronous context, and wherein the computer program performs at least one action while the first call is handled asynchronously. (Paragraphs 0049-0050)

19. The referenced invention allows for a second call through an interrupt, which allows the second call to be processed first, and thus asynchronously. After the second call is executed the parameters of the first call are changed, namely the timer that governs the execution of the first call. If the license check is successful, the application is left in the enabled state until the timer causes the first call to execute, thus actions are allowed between the second and first calls.

20. As to claim 15, Coley further shows:

said first method determines whether the right is exercisable based on one or more factors comprising: whether the license is bound to a machine or environment on which the computer program is executing; whether the license or right is bound to a product identifier associated with the computer program; whether the license or right has expired; (Figure 2 (cont.), #234) and whether the right has been consumed a number of times in excess of a right specified in the license.

21. As the claim says one or more factors, the determination on only one factor is all that needs to be shown to reject the claim.

22. As to claim 16, Coley shows:



- s. A computer-readable medium having encoded thereon computer-executable instructions to perform a method of enabling the enforcement of a license to a computer program, (Abstract, "Licensing system module") the method comprising:
  - t. receiving a first method call from the computer program, the first method call identifying a right in the computer program; (Figure 2, #210)
  - u. determining that the right (execution) is contained in the license and is exercisable (Figure 2, #214) through the use of a license store and a trust store (Paragraph [0018]) having stored therein dynamic data that is stored in a tamper-resistant manner (Paragraph [0093]) and is utilizable to validate the license (Paragraph [0050]); and
  - v. returning to the computer program an indication that the right is exercisable. (Figure 2, #220)
- 23. As to claim 17, Coley further shows:
  - the indication comprises a binding of the right to the license. (Figure 2, #216 & #218)
- 24. The rights are bound to the license based on the ID written to the license. In the simplest form, if a valid ID is written, the license will enable the program to execute. Conversely, if a null ID is written, the program is disabled.
- 25. As to claim 18, Coley further shows:
  - said determining act is based on whether the right is specified in the license. (Figure 2 (cont.), #226 & #228)
- 26. If the ID is valid, which is what the right is based on, the program is enabled. If not, the program is disabled.
- 27. As to claim 21, Coley further shows:

said determining act is based on whether the license or right is non-expired. (Figure 2 (cont.), #234).

28. As to claim 24, Coley further shows:

the method further comprises: receiving a second method call from the computer program; in response to the second method call, returning an asynchronous context to the computer program, wherein the first method call is executed subsequent to the second method call and identifies said asynchronous context; and executing the first method call asynchronously while the computer program performs an action. (Paragraphs 0049-0050)

29. As to claim 25, Coley further shows:

w. the right is associated with a set of data, (Paragraph 0041) and wherein the method further comprises:

x. receiving a second method call which indicates the right; (Figure 2 (cont.), #224)  
and

y. in response to said second method call, providing the set of data to the computer program. (Figure 2 (cont.) #228)

### ***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter

pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Coley.
- z. Coley shows all of the limitations of claim 1 and further shows:
- aa. said licensing component is usable by a plurality of computer programs, the computer program being included among said plurality of computer programs, (Paragraph 0021)
- bb. wherein said callable interface further comprises: a handle-opening method that provides a handle to the computer program; wherein the rights-consumption method receives the handle from the computer program and uses the handle to identify the computer program from which a call to the rights-consumption method is received. (Paragraph 0088)
32. Coley does not show:
- wherein the computer program and licensing component are located on a single computing device.
33. The act of making the program and licensing component integral would have been obvious to one of ordinary skill in the art at the time of the invention. "It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable." (In re Wolfe, 116 USPQ 443, 444 (CCPA 1961); KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)) See also MPEP 2144.04 V (B). In the instant case, it would be desirable to locate the computer

program and the licensing component on the same device, so that a network connection does not have to be present or used in order to validate the license.

34. Claims 3, 6, 7, 19, 20, & 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Coley in view of Hunter.

35. As to claim 3, Coley shows all of the elements of claim 1, but does not show:

the license is one of a plurality of licenses that are stored in said license store, and wherein the rights-consumption method causes the licensing component to select the license based on one or more factors comprising: whether the license store is associated with the computer program; and a conflict rule that determines which license to select from among a plurality of licenses that are associated with the computer program.

Hunter shows a plurality of licenses in a store (Figure 2, #208) being associated with different computer programs (Figure 8; NETLIS\_PRODUCT\_NAME, FLEXLM\_PRODUCT\_NAME & SUNNET\_PRODUCT\_NAME). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Coley to use the multiple license storage of Hunter. This would allow for a common licensing interface for a variety of programs (Abstract).

36. As to claim 6, Coley show everything except:

the computer program and the licensing component execute on a machine, and wherein the rights-consumption method determines whether the right can be exercised based on whether the license is bound to said machine.

37. Hunter shows that the licensing component can bind the rights to the machine that both the software and licensing component are executed on. (Figure 1, #100; Figure 6, #624 & Figure

7). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Coley with the local license handling of Hunter. This configuration allows a single system process to manage multiple licenses (Abstract).

38. As to claim 7, Hunter further shows that the routines called by the system process cited in the 35 U.S.C. 103(a) rejection of claim 6 act as a product identifier (Figure 2, #208). Therefore, the same 35 U.S.C. 103(a) basis is used.

39. As to claim 19, Coley shows all of the elements of claim 16, but does not show:

said determining act is based on whether the license is bound to a machine on which the computer program is executing.

40. Hunter shows that the licensing component can bind the rights to the machine that both the software and licensing component are executed on. (Figure 1, #100; Figure 6, #624 & Figure

7). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Coley with the local license handling of Hunter. This configuration allows a single system process to manage multiple licenses (Abstract).

41. As to claim 20, Coley shows everything except:

said determining act is based on whether the license or right is bound to the computer program.

42. Hunter shows a plurality of licenses in a store (Figure 2, #208) being associated with different computer programs (Figure 8; NETLIS\_PRODUCT\_NAME, FLEXLM\_PRODUCT\_NAME & SUNNET\_PRODUCT\_NAME). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of

Coley to use the multiple license storage of Hunter. This would allow for a common licensing interface for a variety of programs (Abstract).

43. As to claim 23, Coley shows everything except:

the method further comprises: receiving a second method call from the computer program; and in response to the second method call, returning a handle to the computer program that identifies the computer program; wherein said first method call is performed subsequent to said second method call, and wherein said first method call further identifies said handle.

44. Hunter shows the process of obtaining, prior to the call referred to as the “first call” in the instant application, a handle that identifies the program and is used in the “first call” (Figure 3, #306-#314). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Coley to incorporate the handle usage of Hunter because it allows for better control of the application due to the license actually being associated with the location in memory instead of simply the program name.

45. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coley in view of Cooper.

46. Coley shows all of the elements of claim 16, but does not show:

said determining act is based on whether the license has been consumed a number of times that exceeds a limit.

47. Cooper shows a licensing configuration that restricts with certain licenses to a limited number of executions of the software (Column 8, lines 47-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Coley to include the ability to control software executions, as taught by Cooper, in order to allow

for full-featured demos that can only be executed so many times before the demo period expires.  
(Column 8, lines 47-49)

***Response to Arguments***

48. Applicant's arguments, see pages 8 and 9 of Applicants' remarks, filed 16 January 2008, with respect to Hunter and Cooper anticipating the claims as amended have been fully considered and are persuasive. The rejections of 10 December 2007, under 35 U.S.C. 102 using these two references have been withdrawn.

However the claims stand rejected under 35 U.S.C. 103 as being obvious.

49. Applicant's remaining arguments filed 16 January 2008 have been fully considered but they are not persuasive.

50. Applicants argue:

"Coley nowhere teaches a trust store having stored therein dynamic data that is stored in a tamper-resistant manner and is utilizable to validate the license." (Remarks, Page 9, paragraph 1).

51. Examiner's response:

The Examiner has added more citations to show this limitation as amended.

52. Applicants argue:

"With respect to amended claim 4, which is rejected in view of Coley, Coley neither discloses nor suggests "the licensing component does not enforce licensing constraints on the computer program". Coley mandates that any software application having a licensing system

client module attached will not operate unless and until the license system client module receives authority to enable the software application (Coley Paragraph [0054]).” (Remarks, Page 9, paragraph 1).

53. Examiner’s response:

The “licensing system client module” is not the “licensing component” as cited by the Examiner. The Examiner has cited element 110, as the licensing component and the licensing system client module is element 108. Therefore, it is clear that the licensing component cited by the Examiner is *not* the element restricting the operation.

54. Applicants argue:

“[A] prima facie case of obviousness has not been established for the rejection of claim 2” (Remarks, Page 11, paragraph 2)

55. Examiner’s response:

The Examiner was relying on the motivation from the case cited. However, the Examiner has elaborated on this position in this action, hopefully to the satisfaction of Applicants.

***Conclusion***

56. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.



57. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

58. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621